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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,490	11/13/2003	Anne Dussaud	J6866(C)	8338

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EXAMINER	
HOEKSTRA, JEFFREY GERBEN	
ART UNIT	PAPER NUMBER
3736	

MAIL DATE	DELIVERY MODE
01/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/712,490	DUSSAUD ET AL.	
	Examiner	Art Unit	
	JEFFREY G. HOEKSTRA	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 17-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 17-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 November 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2008 has been entered.

Notice of Amendment

2. In response to the amendment filed on 12/22/2008, amended claims 1 and 5 is/are acknowledged. The current rejections of the claims are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3-6, 8-11, and 17-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Non-Patent Literature submission: Abstracts of a presentation at a skin conference in Hamburg, 2003, specifically Flament et al. ("Finger perception metrology. Correlation between friction force and acoustic emission"), hereinafter Flament.

5. For claims 1, 3-6, and 8-11, Flament discloses a tactile acoustic emission measurement and analysis apparatus (Flament et al, pages 168-169), comprising: means for acoustic signal- generating, collecting, storing, displaying, and correlating of frictional forces, wherein said frictional forces are capable of being operably generated via animal skin on one area rubbing animal skin on another area when skin on one area of the body slides or rubs on skin on another area of the body (i.e. skin/skin frictional forces), and wherein said apparatus is capable of use as a clinical evaluation tool of skin attributes (Flament et al, pages 168-169). Said apparatus is capable of being used by consumers or clinicians (e.g. a beautician or professional advisor) to study/evaluate the impact the effect of the application cosmetic compositions that affect skin attributes, including: hydration, texture, roughness, porosity, wrinkles, and pathologies of cutaneous tissue (psoriasis, eczema, dry skin, etc...) (Flament et al, pages 168-169) and (b) a medium for indicia of at least said two said skin attributes (i.e. test results) that allows said clinician to distinguish the effect of said application of cosmetic composition (Flament et al, pages 168-169). The apparatus as disclosed by Flament is capable of being placed alongside a container holding said cosmetic composition and facilitating cosmetic composition selection based on the determined skin attributes.

6. For claims 17-20, Flament discloses a system that is used in air, wherein the acoustic emission signal is generated from a hand or finger and a second body part (Flament et al, pages 168-169).

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flament in view of Fleming (Non-Patent Literature submission: Abstracts of a presentation at a skin conference in Hamburg, 2003, Fleming "Mobile, multimedia computing for improved clinicopathologic correlation in dermatopathology"). Flament discloses the claimed invention, as set forth and cited above, except for expressly disclosing a means for digitally displaying test result signals via the internet and/or handheld software. Fleming teaches a means for digitally displaying test result signals via the internet and/or handheld software (Fleming, pages 170-171). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Flament and Fleming. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Flament with the components as taught by Fleming to achieve the predictable results of providing an alternate means to display diagnostic data.

Response to Arguments

9. Applicant's arguments filed 12/22/2008 with respect to the anticipatory and obviousness rejections of the claims under Flament have been fully considered but they are not persuasive. Applicant argues Flament teaches away from the claimed invention "which creates emission signals from a body by contacting skin-on-skin" or wherein "the acoustic emission signal is emitted when skin on one area of the body slides or rubs on skin on another area of the body". The Examiner disagrees, maintains the rejection as set forth and reiterated above, and in response notes the following:

10. As an Initial matter, the Examiner notes that the "teaching away" argument with regards to Flament does not appear to be applicable to the anticipatory rejection of the claims set forth and reiterated above and is most appropriately presented in an obviousness type rejection wherein multiple teachings are used in a rejection.

11. Assuming arguendo Applicant intended to argue Flament does not disclose, teach, and/or fairly suggest the claimed invention "which creates emission signals from a body by contacting skin-on-skin" or wherein "the acoustic emission signal is emitted when skin on one area of the body slides or rubs on skin on another area of the body" The Examiner disagrees, maintains the rejection as set forth and reiterated above, and in response notes the following:

12. In response to applicant's argument that Flament does not disclose, teach, and/or fairly suggest the claimed invention "which creates emission signals from a body by contacting skin-on-skin" or wherein "the acoustic emission signal is emitted when skin on one area of the body slides or rubs on skin on another area of the body", a

recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.*

13. In the instant case, the Examiner notes that

- (a) Flament discloses "We have established a good correlation between the force of friction and the acoustic signal, so the measures made with the finger, provided with an acoustic sensor on the skin, allow to the clinicians and to the cosmetic industry to estimate the sensory properties while making a natural gesture of the touch. The device can be used to study the impact of a cosmetic formulation on the skin by evaluating the variations of sweetness, adhesion but especially effect of hydration as well as pathologies of the cutaneous tissue (psoriasis, eczema, dry skins...)",
- (b) the apparatus as disclosed by Flament is capable of the intended use or functional limitations comprising "by contacting skin on one area of the body with skin on another area of the body to produce skin/skin frictional forces", and
- (c) the disclosure of Flament provides various examples of testing frictional forces on various abrasive surfaces as noted by Applicant however as noted in (a) Flament is expressly concerned with the efficacy of the device to function as a skin-on-skin diagnostic apparatus.

14. It appears Applicant relies heavily upon the intended use of the claimed invention and/or the process by which the product operates (i.e. a product-by-process claim limitation) for patentability. The Examiner reiterates the disclosure of Flament

anticipates the claimed invention and presently there are no structural distinctions between the claimed invention and Flament's disclosure because Flament's disclosure anticipates and/or is capable of the positively recited intended uses (i.e. at least "wherein said system is used as a clinical tool to evaluate efficacy of cosmetic skin care and/or cleansing products" and "further wherein the acoustic emission signal is emitted when skin on one area of the body slides or rubs on skin on another area of the body")

15. The Examiner notes the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736